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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965.

No. 288

WELSH CO.,

Petitioner,

vs.

VICTOR A. CHERNIVSKY, d/b/a COMFY BABE COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

REPLY TO PETITION FOR CERTIORARI.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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THE PARTIES AND THE FACTUAL SITUATION.

This is a perfectly common patent infringement action which is of no great importance to anybody but the parties —and perhaps a few jackals of the type that exist in every industry, who are weaker and more timid than Welsh, the Petitioner, and are lying in the weeds to see whether Respondent Victor Chernivsky's patent—the protector of his small business flock—is the large and reliable shepherd

dog seen by the Court of Appeals, or the weak and toothless puppy that the District Court made of it.

Victor Chernivsky devised the proverbial "better mousetrap" in the form of a simple and very unique chair-like support which is the first safe "sit up" device for infants only a few weeks old. The world did beat a path to his door—and with only modest promotion on his part, as the District Court found in its holding of commercial success. The promotion had to be modest—Chernivsky was running a one-man operation out of his home, ably assisted by his wife, trying to realize the American Dream of establishing their own business which would give their large family the better things that all of us want.

When Chernivsky's dream was just approaching reality through the success of his device in the market place, The Welsh Co., one of the giants of the baby equipment industry, muscled in with a unit which its patent lawyer advised it did not infringe the patent that Chernivsky had obtained. Chernivsky's patent counsel took a contrary view, a notice of infringement went to Welsh, and a declaratory judgment action was filed by Welsh immediately. The District Court agreed with Welsh's attorney, while the Court of Appeals agreed with Chernivsky's. The Court of Appeals' opinion in this case represents the American patent system at its very best—working to protect the fledgling business man against the maraudings of the big, well established intruder. So much for the human side of this case.

THE "QUESTION PRESENTED" BY PETITIONER MISSTATES THE COURT OF APPEALS HOLDING.

The Court of Appeals did not hold that any element of the combination claimed by the patent is omitted from the Welsh chair. It found that Chernivsky combined old elements in a manner that was unobvious to one skilled in the trade and produced a new and useful result so that the combination was a patentable device (Pet. App. 19). It further found that the Welsh device accomplishes "the same result as the patent device by substantially the same means and that it is the equivalent thereof" (Pet. App. 15). In analyzing the Welsh claim, it found that every element of the patented combination, or its mechanical equivalent, is present (Pet. App. 14-15).

THE "ERROR OF LAW" ALLEGED BY PETITIONER IS SPURIOUS.

Petitioner seeks to give the present case a public importance which would justify review by the Supreme Court. It does so by taking one part of the Court of Appeals' opinion out of context, and saying, in effect: "This is an error of law which requires correction because it establishes a dangerous precedent."

The basic error in the Petition is that the Court of Appeals did not hold what Welsh says it did. The language is accurately quoted, but because it is out of context, it is misconstrued. The Chernivsky baby chair is a new combination of a specialized separable base and back rest. The District Court found that the only patentable novelty was in a particular structure at the extremities of the base which requires a special springing engagement that gives a tight frictional lock when the base and the back rest are assembled. It further found that the proceedings

in the Patent Office created a file wrapper estoppel so that any device lacking the special springing engagement is no infringement.

In reviewing the District Court's decision, the Court of Appeals for the Seventh Circuit first compared the Welsh infringing structure with the patented structure and concluded that the Welsh chair accomplishes the same result by substantially the same means, and that it is an equivalent of the patented device. Next the Court addressed itself to the question of whether there is a file wrapper estoppel which prevents application of the doctrine of equivalents. It reviewed the documentary evidence of the file wrapper and concluded that the claim in question was not narrowed during the Patent Office prosecution. Thus there is no file wrapper estoppel to prevent application of the doctrine of equivalents, so its finding that the Welsh chair infringes by using mechanical equivalents is legally sound.

The Court of Appeals analyzed the error of the District Court as a failure to recognize that the Chernivsky structure is a novel and patentable combination of elements in an unobvious manner which produces a new and useful result. Since such a combination alone is patentable, the addition of a novel element to the combination does not require that the invention be limited only to the novel element. The holding is entirely consistent with the law as heretofore enunciated.

INCORRECT OR MISLEADING STATEMENTS IN THE PETITION.

Certain statements in the Petition for Certiorari are so incorrect or misleading as to require direct comment:

(1) Contrary to Welsh's erroneous assertions in "The Omitted Feature" (page 5) and in "Reasons for Granting the Writ" (page 6) the Welsh structure does not eliminate

any element of claim 1 of the Chernivsky patent. Every element of the claim, including the novel element, finds its precise counterpart or mechanical equivalent in the Welsh baby chair. Admittedly, the specific structure utilized by Welsh does not provide as tight a connection as that found in Chernivsky's commercial structure—at least when the chair is not occupied (Pet. App. 15); but it is an equivalent of that structure—which is the structure of claim 1.

> (2) "The Patent Office and both Courts found the features of the patented device to be old or obvious from disclosures of prior patents with the exception of the deflected end extremities of the base that produce the tight fit, or friction lock." (p. 4.)

The Patent Office made no such finding—if it had there would have been no infringement charge against Welsh. The Court of Appeals made no such finding—if it had there would have been no holding of infringement.

(3) Under the heading "Procedure in the Patent Office" (p. 5), Petitioner presents its version of the proceedings which it thinks resulted in a file wrapper estoppel. The Court of Appeals disagreed with Petitioner's version of the contents of the file wrapper and its legal effect. The Court's treatment of the alleged file wrapper limitation requires three pages, starting on page 15 of Petitioner's Appendix A. We, of course, think the Court of Appeals' construction of the File Wrapper is entirely right. Nevertheless, whether right or wrong, it is of concern only to those immediately interested in the patent, and lacks any such impact on the due administration of justice as to provide a sound basis for the grant of certiorari by this Court. This despite Petitioner's earnest protestations to the contrary in "Reasons for Granting the Writ" (II, p. 8).

THE ALLEGED "SINGLE NOVEL FEATURE."

Petitioner bases much of its argument on the erroneous premise that the patent depends for its patentability over the prior art upon a single feature of construction. The Court of Appeals held that the invention resides in the novel combination of elements which produces a new and useful result; so the premise upon which petitioner bases its argument is clearly without foundation. The rhetorical question posed by Petitioner at the top of page 10 manifests this faulty premise and smoke-screen argument:

> "Why should the omission of the novel element from the combination avoid infringement in the case where the old elements of the combination are found in a single device of the prior art, but not where shown to be old, respectively, in several prior art devices? **In each case the addition of the novel element was the factor that made the device patentable and accounted for the grant.**" (Emphasis ours.)

It is only where all the elements are found in a single prior art device that the addition of a novel element is the factor that accounts for the grant. Where various elements must be selected from several different prior art devices, the composite device may be patented as a new combination even if there is no single wholly new element. *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366, 381 (1909); *Loom Co.* v. *Higgins,* 105 U. S. (15 Otto) 580, 591 (1881). In such a case, if a new element is also present it is not the new element that makes the combination patentable. That is precisely the situation here.

What petitioner really seeks from this Court is a new set of findings of fact and not the correction of an allegedly erroneous rule of law. Contrary to petitioner's statement following the rhetorical question, the addition of a novel element is not the factor that makes the Chernivsky

device patentable, for the Court of Appeals clearly held that the structure is a patentably new combination which further includes a novel element.

The Court of Appeals' decision is manifestly correct, creates no new law when properly construed, and certiorari should therefore be denied.

Respectfully submitted,

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END